

Response under 37 C.F.R. §1.116

Attorney Docket No. **010377**

Serial No. **09/813,303**

REMARKS

Claims 1 – 11 and 13 - 19 are pending in the present application, of which claims 6, 7, 9, 10, 11 and 15 have been withdrawn from consideration. By this Amendment, claim 1 has been amended. No new matter has been added. It is respectfully submitted that this Amendment is fully responsive to the Office Action dated August 23, 2004.

As to the Merits:

As to the merits of this case, the Examiner relies on the newly cited reference of Stegens (U.S. Patent No. 3,940,706) in setting forth the following rejections:

- 1) claim 1 is rejected under 35 USC 103(a) as being unpatentable over Vinn et al. (U.S. Patent No. 4,717,888, of record) in view of Shaw (U.S. Patent No. 2,787,560, of record) and Stegens (U.S. Patent No. 3,940,706);
- 2) claims 1-5, 8, and 14 are rejected under 35 USC 103(a) as being unpatentable over Holt page 384 of “Electronic Circuits” in view of Vinn, Stegens and Shaw; and
- 3) claims 13 and 16-19 are rejected under 35 USC 103(a) as being unpatentable over Holt page 384 of “Electronic Circuits” in view of Vinn, Stegens and Shaw and further in view of Campbell et al. (U.S. Patent No. 5,546,033, of record).

Each of these rejections is respectfully traversed.

Claim 1, as amended, now calls for *at least one of said first and second circuits comprising one or a plurality of thin film resistors, wherein said one or plurality of thin film resistors have a thickness smaller than three times its skin depth at a predetermined frequency in the range of 1 GHz to 10 GHz, and wherein a resistance value of said one or plurality of thin film resistors varies with respect to a frequency in the range of 1 GHz to 10 GHz by a skin effect.*

With regard to Applicants' argument that Shaw fails to disclose the subject matter of the present invention utilizing such a characteristic that the resistance value of a metal film resistor having a certain film thickness is changed with respect to a frequency by a skin effect, the Examiner takes the position that "the claims do not recite and are not limited to 'resistance value of a metal film resistor having a certain film thickness is changed with respect to a frequency by a skin effect.'"¹

However, it is respectfully submitted that claim 1, as amended, now clearly calls for *wherein a resistance value of said one or plurality of thin film resistors varies with respect to a frequency in the range of 1 GHz to 10 GHz by a skin effect.*

In addition, the Examiner asserts that "because of the composition of Shaw and the above fact that Shaw has the condition set forth by applicant above, i.e. 'a thickness smaller than three times its skin depth at a predetermined frequency' in the microwave range, it appears that Shaw would inherently have the unclaimed function above and applicant has not pointed to any differences in structure or to anything in Shaw that would prevent Shaw from having its

¹ Please see, lines 14 – 16, page 5 of the outstanding Action.

unclaimed feature even it was claimed.”²

However, it is respectfully submitted that the Examiner’s position is lacking and unreasonable, since it is a main objective of Shaw’s invention “to produce a resistor having unaltered resistive characteristics over a frequency range of from zero to billions of cycles per second.”³

Accordingly, since it is a main objective of Shaw to realize an unaltered resistive characteristics over the entire frequency spectrum, it seems quite clear that Shaw is not concerned at all with the resistance value of a metal film resistor having a certain film thickness being changed with respect to a frequency by a skin effect.

As such, it is submitted that Shaw, and the other applied references of Vinn et al. and Stegens, fail to disclose the features of claim 1, as amended, concerning *wherein a resistance value of said one or plurality of thin film resistors varies with respect to a frequency in the range of 1 GHz to 10 GHz by a skin effect.*

In view of the aforementioned amendments and accompanying remarks, Applicants submits that the claims, as herein amended, are not anticipated or obvious over the cited references, and therefore the application is in condition for allowance. Applicants request such action at an early date.

² Please see, lines 20 – 25, page 5 of the outstanding Action.

³ Please see lines 31-34, column 1 of Shaw.

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If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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